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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/813,852 03/07/97 DOCKERY

R 21651.3

EXAMINER

TM02/0730

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ART UNIT

PAPER NUMBER

2167

DATE MAILED:

07/30/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SR

Office Action Summary

Application No.

08/813852

Applicant(s)

R.L. DOCKERY

Examiner

F. J. BARTUSKI

Group Art Unit

2167

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on JUNE 14, 2001
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4, 10 AND 17-28 is/are pending in the application.
- Of the above claim(s) 1, 4, 10 AND 26-28 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 18-25 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group II, claims 18-25 in Paper No. 27 is acknowledged.
2. Claims 1, 4, 10, 17 and 26-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 27.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the February 1996 Consumer Reports magazine. The February 1996 Consumer Reports magazine includes a plurality of articles as shown in the

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table of contents, the article on receivers on pages 28 and 29 identifies products by brand name, includes information pertaining to the products and promotes purchase of some of the products by making best buy recommendations.

5. Claim 18 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bullard, Jr. Bullard, Jr. shows a magazine, booklet, book, catalog or pamphlet, see col. 2, lines 30-33, that includes a plurality of articles promoting the purchase of a plurality of products, each article includes information pertaining to one of the products, see col. 2, lines 51-65.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Lamphere et al. Bullard, Jr. shows a magazine with all the features of the applicants' claimed invention except for the magazine being specific to a particular store. Lamphere et al show a promotional booklet that is specific to a particular store, see col. 10, lines 51-61. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Lamphere et al to make the magazine of Bullard, Jr. specific to a particular store to aid shoppers in finding the advertized products.

8. Claims 18 and 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Lamphere et al. Bullard, Jr. shows a magazine with all the features of the applicants' claimed invention except for disclosure of who commissioned the articles. It would have been obvious to one of ordinary skill in the art in view of the disclosure in col. 9, lines 5-12 of Lamphere et al to sell advertising space in Bullard, Jr. to store brands or national brands.

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9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Lamphere et al as applied to claim 21 above. Further, it would have been obvious to one of ordinary skill in the art in view of the store name on the cover of the booklet in Fig. 4 of Lamphere et al to place the store name on the cover of the magazine of Bullard, Jr. so the shopper takes the right magazine to each store.

10. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard, Jr. in view of Shedd. Bullard, Jr. shows a magazine with all the features of the applicants' claimed invention except the coupons. It would have been obvious to one of ordinary skill in the art in view of the coupons 3 in the promotional book of Shedd to provide the magazine of Bullard, Jr. with coupons to encourage sales.

Response to Arguments

11. The applicants' remarks have been considered but have not been found persuasive because the "Best Buy" recommendation in the Consumer Reports magazine article clearly promotes the purchase of that product and therefore the Consumer Reports magazine is for use, at least in part, in promoting the purchase of a specific product. Further, notice the advertisement for the

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“Complete Drug Reference” also on page 29 of the Consumer Reports magazine; which is an article that promotes the purchase of a specific product.

The applicants’ remarks that Bullard does not contain general interest articles is not persuasive because of the disclosure in col. 2, lines 30-33 of Bullard that the advertising media includes magazines, books and newspapers, all of which are known to include general interest articles. Bullard does not disclose that the booklets include only advertising as the applicants seem to be arguing.

The applicants’ remarks with respect to the rejections under 35 USC 103 have not been found persuasive because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication should be directed to F. J. Bartuska at telephone number (703) 308-1111.

**F. J. BARTUSKA
PRIMARY EXAMINER**